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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/045,799 03/23/98 HAYASHI

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MM51/0728

EXAMINER

TAMAI, K

ART UNIT

PAPER NUMBER

2834

4

DATE MAILED:

07/28/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/045,779

Applicant(s)

Hayashi et al.

Examiner

Tamai, Karl I.E.

Group Art Unit

2834



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) 7 and 8 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Mar 23, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 09/045,799

2

Art Unit: 2834

Attorney Docket: Q49782

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to an insert conductor apparatus, classified in class 174, subclass 250.
  - II. Claims 7 and 8, drawn to method of manufacturing a brush holder, classified in class 29, subclass 597.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as insert conductor for other apparatus than a brush holder, such as an integrated circuit or position sensors, AND the insert conductor can be made by a different method than Group II, such as without the brush holder. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, different search requirements, and because of the recognized divergent subject matter, the restriction for examination purposes as indicated is proper.

Serial Number: 09/045,799

3

Art Unit: 2834

Attorney Docket: Q49782

4. During a telephone conversation with Robert J. Seas, Jr. (#21,092) on July 14, 1998 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 and 8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Drawings*

6. Figures 8-17 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

#### *Specification*

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Serial Number: 09/045,799

4

Art Unit: 2834

Attorney Docket: Q49782

8. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne et al.(Byrne) and Nakazawa et al.(Nakazawa). Byrne teaches a conductor having a plurality of wires 17, an outer frame 18 and connections 17b, and a plastic plate 13 which supports the plurality of wires in the encapsulated body. The plastic plate 13 inherently helps prevent deformation of the wires during encapsulation in an insulating body. Byrne teaches the wires are encapsulated in plastic. Nakazawa teaches an insert conductor which is encapsulated by resin insert molding. It would have been obvious to a person skilled in the art at the time of the invention to construct the insert conductor of Byrne with the insert conductor sealed by resin insert molding because Nakazawa teaches that resin effectively seals the conductor and circuit elements from the outer environment with a compact thickness, and because Byrne suggests that any suitable insulating material can be used.

Serial Number: 09/045,799

5

Art Unit: 2834

Attorney Docket: Q49782

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Nakazawa, in further view of Huber. Byrne and Nakazawa teach every aspect of the invention, as discussed above, except the insert conductor and plastic plate deform preventer used in as a connector in a brush holder. Byrne teaches an encapsulated wiring device with the internal wires having an insulating support. Huber teaches an insert conductor molded in a brush holder. It would have been obvious to a person skilled in the arts at the time of the invention to construct the insert conductor of Byrne in a brush holder because Huber teaches that insert conductors with are molded into brush holders to form an integrated body, and with the plastic plate of Byrne because it provides insulating support to the wires.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Nakazawa, in further view of Yoshida. Byrne and Nakazawa teach every aspect of the invention, as discussed above, except the deformation preventer composed of polyphenylene sulfide resin. Yoshida teaches that polyphenylene sulfide is used in is used in integrated circuits as an insulating layer. It would have been obvious to a person skilled in the art at the time of the invention to construct the insert conductor of Byrne with the deform preventer made of polyphenylene sulfide resin because Yoshida teaches that polyphenylene sulfide resin provides good adhesion and a firm adhesive property.

Serial Number: 09/045,799

6

Art Unit: 2834

Attorney Docket: Q49782

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Helda teaches a similar insert conductor.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (703) 305-7066. The examiner can be normally contacted on Monday through Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nestor Ramirez, can be reached at (703)308-1371. The facsimile number for the Group is (703)305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1782.

KIT *lit*

July 18, 1998

  
NESTOR RAMIREZ  
PRIMARY EXAMINER  
GROUP 2800